



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/758,718

01/16/2004

Stephen C. Jacobson

1875-0532.3

6560

110

7590

09/11/2007

DANN, DORFMAN, HERRELL & SKILLMAN

1601 MARKET STREET

SUITE 2400

PHILADELPHIA, PA 19103-2307

EXAMINER

NOGUEROLA, ALEXANDER STEPHAN

ART UNIT

PAPER NUMBER

1753

MAIL DATE

DELIVERY MODE

09/11/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/758,718	Applicant(s) JACOBSON ET AL.	
	Examiner ALEX NOGUEROLA	Art Unit 1753	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/18/2004</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Double Patenting

1. It should be noted that although the Utility Patent Application Transmittal sheet (received January 16, 2204) indicates that the instant application is a divisional application prior application No. 09/759,590 no restriction requirement was made by the PTO in the application No. 09/759,590. Thus, the instant application is a voluntary divisional application.

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claim 1 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 9 of prior U.S. Patent No. 6,790,328. This is a double patenting rejection.

Art Unit: 1753

4. Claim 2 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 10 of prior U.S. Patent No. 6,790,328. This is a double patenting rejection.

5. Claim 3 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 12 of prior U.S. Patent No. 6,790,328. This is a double patenting rejection.

6. Claim 19 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 11 of prior U.S. Patent No. 6,790,328. This is a double patenting rejection.

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

Art Unit: 1753

be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claim 4 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the combination of claim 9 and claim 6 of U.S. Patent No. 6,790,328 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 9 of U.S. Patent No. 6,790,328 B2 recites all of the limitations of underlying claim 1 of the instant application and claim 6 of U.S. Patent No. 6,790,328 B2 provides, in a corresponding apparatus claim, a second focusing channel structured as claimed and that function as claimed since there is "means for driving the focusing material in said second focusing channel such that the said sample stream is spatially confined in said chamber."

9. Claim 5 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the combination of claims 9, 6, and 12 of U.S. Patent No. 6,790,328 B2. Claim 4, from which claim 5 depends, has been addressed above. Although the conflicting claims are not identical, they are not patentably distinct

from each other because claim 12 of U.S. Patent No. 6,790,328 B2 provides the same additional limitations as required by claim 5 of the instant application.

10. Claim 6 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 9 of U.S. Patent No. 6,790,328 B2.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the method of claim 9 of U.S. Patent No. 6,790,328 B2 requires an apparatus as set forth in claim 6 of the instant application.

11. Claim 7 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 10 of U.S. Patent No. 6,790,328 B2.

Claim 6, from which claim 7 depends, has been addressed above. Although the conflicting claims are not identical, they are not patentably distinct from each other because the additional method step of claim 10 of U.S. Patent No. 6,790,328 B2 implies the additional means of claim 7 of the instant application.

Art Unit: 1753

12. Claim 8 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 12 of U.S. Patent No. 6,790,328 B2.

Claim 6, from which claim 8 depends, has been addressed above. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method of claim 12 of U.S. Patent No. 6,790,328 B2 requires an apparatus as set forth in claim 8 of the instant application.

13. Claim 9 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the combination of claims 9 and 6 of U.S. Patent No. 6,790,328 B2. Claim 6 of the instant application, from which claim 9 depends, has been addressed above. Although the conflicting claims are not identical, they are not patentably distinct from each other because the second focusing channel and means for transporting a second stream of the focusing material of claim 9 of the instant application is provided by claim 6 of U.S. Patent No. 6,790,328 B2, which is directed to a closely related apparatus for performing the method of claim 9 of U.S. Patent No. 6,790,328 B2.

Art Unit: 1753

14. Claim 10 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the combination of claims 9, 6, and 4 of U.S. Patent No. 6,790,328 B2. Claim 6 of the instant application, from which claim 10 depends, has been addressed above. Although the conflicting claims are not identical, they are not patentably distinct from each other because the specified means for transporting the stream of focusing material of claim 10 of the instant application is provided by claim 4 of U.S. Patent No. 6,790,328 B2, which is directed to a closely related apparatus for performing the method of claim 10 of U.S. Patent No. 6,790,328 B2.

15. Claim 11 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the combination of claims 10 and 5 of U.S. Patent No. 6,790,328 B2. Claim 7 of the instant application, from which claim 11 depends, has been addressed above. Although the conflicting claims are not identical, they are not patentably distinct from each other because the specified means for transporting the stream of focusing material and buffer material of claim 11 of the instant application is provided by claim 5 of U.S. Patent No. 6,790,328 B2, which is directed to a closely related apparatus for performing the method of claim 11 of U.S. Patent No. 6,790,328 B2.

16. Claim 12 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the combination of claims 10 and 5 of U.S. Patent No. 6,790,328 B2. Claim 8 of the instant application, from which claim 12 depends, has been addressed above. Although the conflicting claims are not identical, they are not patentably distinct from each other because the specified means for transporting the stream of focusing material and buffer material of claim 12 of the instant application is provided by claim 5 of U.S. Patent No. 6,790,328 B2, which is directed to a closely related apparatus for performing the method of claim 12 of U.S. Patent No. 6,790,328 B2. As for the claimed means for transporting the volume segment of the narrowed first material, although not mentioned in claim 5 of the instant application it would have been obvious to one with ordinary skill in the art at the time of the invention to use electrokinetic means or pressure driven means because these are already disclosed as being used for transporting the focusing material and the buffer material.

17. Claim 13 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the combination of claims 9 and 5-7 of U.S. Patent No. 6,790,328 B2. Claim 9 of the instant application, from which claim 13 depends, has been addressed above. Although the conflicting claims are not identical,

Art Unit: 1753

they are not patentably distinct from each other because the specified means for transporting the stream of focusing material, buffer material, and second stream of focusing material of claim 13 of the instant application is provided by claims 5 and 7 of U.S. Patent No. 6,790,328 B2, which are directed to a closely related apparatus for performing the method of claim 13 of U.S. Patent No. 6,790,328 B2.

18. Claim 14 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 12 of U.S. Patent No. 6,790,328 B2.

Claim 3 of the instant application, from which claim 14 depends, has been addressed above (statutory-type double patenting). Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 12 requires dispensing the first material into the fourth channel, so it would have been obvious to one with ordinary skill in the art at the time of the invention to reverse the direction of the transporting of the stream of the first material in the first channel because this will allow control over the volume of first material dispensed into the fourth channel.

19. Claim 15 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the combination of claims 9, 6, and 12 of U.S. Patent No. 6,790,328 B2. Claim 5 of the instant application, from which claim 15

Art Unit: 1753

depends, has been addressed above. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 9 requires dispensing the first material into the fourth channel, so it would have been obvious to one with ordinary skill in the art at the time of the invention to reverse the direction of the transporting of the stream of the first material in the first channel because this will allow control over the volume of first material dispensed into the fourth channel.

20. Claim 16 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 12 of U.S. Patent No. 6,790,328 B2.

Claim 8 of the instant application, from which claim 16 depends, has been addressed above. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 12 requires dispensing the first material into the fourth channel and transporting it therein, so it would have been obvious to one with ordinary skill in the art at the time of the invention to reverse the direction of the transporting of the stream of the first material in the first channel because this will allow control over the volume of first material dispensed into the fourth channel.

Art Unit: 1753

21. Claim 17 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the combination of claim 9 and claim 8 of U.S. Patent No. 6,790,328 B2. Claim 4 of the instant application, from which claim 17 depends, has been addressed above. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 8 requires that "... said focusing material driving means comprises means for controlling the flow of the focusing material in said first and second focusing channels such that the sample stream is spatially confined substantially along the center axis of said chamber."

22. Claim 18 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the combination of claims 9 and 8 of U.S. Patent No. 6,790,328 B2. Claim 9 of the instant application, from which claim 18 depends, has been addressed above. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 8 requires that "... said focusing material driving means comprises means for controlling the flow of the focusing material in said

Art Unit: 1753

first and second focusing channels such that the sample stream is spatially confined substantially along the center axis of said chamber."

Claim Rejections - 35 USC § 112

23. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

24. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 12 the phrase "the means for transporting the buffer material," is listed twice in succession in lines 3-4. The second occurrence of this phrase appears to be redundant.

Art Unit: 1753

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALEX NOGUEROLA whose telephone number is (571) 272-1343. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, NAM NGUYEN can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alex Noguera
Primary Examiner
AU 1753

September 7, 2007